

REMARKS

The present remarks are in response to the Office Action dated October, 16 2006, in which the Examiner rejected claims 1, 3-6, 8-12, 14 and 16-19. The Applicant has amended claims 1, 8 and 14. Independent claims 1, 8 and 14 include the feature of claims 3, 9 and 16, respectively, which are now canceled. No new matter has been added. Reconsideration and allowance of claims 1, 4-6, 8, 10-12, 14 and 17-19 in view of the amendments and the following remarks are respectfully requested.

A. Summary of Office Action

An Office Action dated October 16, 2006, was issued indicating that Applicant's Request for Continued Examination had been accepted. The Office action indicated that claim 1, 3-6, 8-12, 14, and 16-19 have been rejected.

The grounds for rejection of claim 1, 4-6, 8, 10-12, 14, 17-19 are rejected under 35 U.S.C. 102 (b) as being anticipated by Takeshi (JP08-307497, hereinafter referred to as "Takeshi"). Takeshi teaches a portable telephone that functions as a facsimile. (See Paragraph 0001 of the Takeshi).

The grounds for rejection of claim 3, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeshi in view of Toyoda et al. (US2002/0160725A1, hereinafter referred to as "Toyoda"). Toyoda relates to a portable phone capable of minimizing absorption of an electromagnetic energy radiated therefrom by a human body when in use thereof. (See Paragraph 0003 of Toyoda).

B. Rejection of Claims Under 35 USC § 102

The Examiner bears the initial duty of supplying the factual basis supporting a rejection of a pendent application, including a rejection based on anticipation.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations.

RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipissimum verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). MPEP 2131.

In general, the Applicant respectfully submits that the Examiner has failed to recognize the following language in independent claims 1, 8, and 14 that states that the second side surface is adapted to increase the distance between the user head and the antenna and reduce electromagnetic interference (EMI) between the user head and the antenna. Nowhere does Takeshi teach this limitation.

Notably, the Examiner acknowledges this limitation referencing Takeshi's Paragraphs 0016-0025, and 0034-0038. See Page 3 of Examiner's Office Action.

However, nowhere in Takeshi is any reference made to EMI and reducing EMI between the user head and the antenna.

Since the Examiner's reference to Takeshi fails to teach each limitation in the claim, the Applicant respectfully submits that the Examiner has not satisfied the prima facie requirements for the 102(b) anticipation rejection.

Regarding dependent claims 4-6, the Examiner again relies on Takeshi. Since dependent claims 4 – 6 rely on claim 1, and the Examiner has not met the prima facie elements for a 102 rejection for claim 1, then the Examiner has not provided sufficient justification for a 102 anticipation rejection.

Although the Examiner does not provide any arguments for claims 10-12, and 17-19, the Applicant assumes that the same arguments that applied to claim 4 – 6 are also being applied to claims 10-12 and claims 17-19. Note, the Examiner made substantive arguments directed to claims 10-12 and 17-19 in the 103 obviousness portion of the Examiner's action. The Applicant could not understand the basis for the 103 rejection in view of the basis for rejection of claims 4-6 being subject to a 102 rejection. Regardless, with respect to claims 10-12 and 17-19, the Applicant refers to the arguments made above that the Examiner has failed to show that Takeshi teaches the second side surface being adapted to increase the distance between the user head and the antenna and reduce electromagnetic interference (EMI) between the user head and the antenna.

However, to expedite the prosecution of this patent application, the Applicant has amended independent claim 1, 8 and 14 to include a printed circuit board situated within

the housing where the printed circuit board is substantially coplanar with the front surface; this amended claim language is taken from cancelled claims 3, 9 and 16.

Clearly, the amended independent claims 1, 8, and 14 overcome the 35 USC § 102 rejection, as noted by the Examiner's 103 rejection, which states that claims 3, 9, and 16 are subject to a 103 obviousness type rejection. Additionally, the Applicant respectfully submits that the dependent claims 4-6, 10-12 and 17-19 overcome the anticipation rejection.

C. Prior Art Rejections (35 U.S.C. §103)

Claims 3, 9, and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Takeshi in view of Toyoda. Since the Applicant has integrated the language from claims 3, 9, and 16 into each of the independent claims 1, 8, and 14, the Applicant respectfully submits that the appropriate rejection for the currently amended claims is a 103 rejection; however, even this rejection is improper because the *prima facie* elements for an obviousness rejection have not been satisfied.

As stated in Section 2143 of the MPEP:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure. Section 2143, MPEP Rev. 2.0, May 2004, pg. 2100-129.

The Examiner states that Takeshi differs from claims 3, 9, and 16 in that Takeshi does not explicitly teach the following: circuit board situated within housing where the printed circuit board is substantially coplanar with the front surface. The Examiner then argues that Toyoda discloses a portable telephone which teaches a circuit board 3 (Fig. 1) situated within the housing where the printed circuit board is substantially coplanar with the front surface (Fig. 1, Paragraph 0049). The Examiner then argues that it would be "obvious to one of ordinary skill in the art at the time of the invention to modify Takeshi's system ... for the portable telephone as shown by Toyoda, thus providing a compact way to accommodate all circuit components for a portable telephone. See Page 4 of the Examiner's Action.

First, the Examiner's prior art references do NOT teach or suggest all the claim limitations. The Examiner's October 16, 2006 action does not provide a reference that teaches the second side surface being adapted to increase the distance between the user head and the antenna and reduce electromagnetic interference (EMI) between the user head and the antenna, and a printed circuit board situated within the housing where the printed circuit board being substantially coplanar with the front surface.

Clearly, Takeshi does NOT teach the second side surface being adapted to increase the distance between the user head and the antenna and reduce electromagnetic interference (EMI) between the user head and the antenna, and a printed circuit board situated within the housing where the printed circuit board being substantially coplanar with the front surface.

Toyoda teaches a printed circuit board 3 situated within a housing where the printed circuit board is coplanar with the front surface as shown in FIG. 1 of Toyoda.

However, Toyoda does NOT teach the second side surface being adapted to increase the distance between the user head and the antenna and reduce electromagnetic interference (EMI) between the user head and the antenna, and a printed circuit board situated within the housing where the printed circuit board being substantially coplanar with the front surface as claimed.

Second, there is no suggestion or motivation, either in the Takeshi and/or Toyoda reference to modify the references or combine references to increase the distance between the user head and the antenna to reduce EMI, and printed circuit board substantially coplanar to the front surface as claimed. Notably, the motivation in Takeshi is to provide a portable telephone with a facsimile for transmission and reception. See Takeshi, Paragraph 0001. In Toyoda, the motivation is to reduce electromagnetic energy by using a shield case surrounding the printed circuit board so as to suppress electromagnetic interference between the printed circuit board and the antenna. See Toyoda, Abstract.

Third, the Examiner failed to provide any knowledge generally available to one of ordinary skill in the art, to modify or combine Takeshi and/or Toyoda that would result in increasing the distance between the user head and the antenna to reduce EMI, and printed circuit board substantially coplanar to the front surface as claimed. The Examiner states "the printed circuit board substantially coplanar with the front surface as ... providing a compact way to accommodate all circuit components." See Page 4 Examiner's Action. Thus, not only has the Examiner ignored the reduction of EMI, but the Examiner has failed to address the PCB being substantially coplanar to the front face of the communication device.

Finally, there is no discussion in either Takeshi, Toyoda, or in the Examiner's Action that there is a reasonable expectation of successfully achieving the results of the claimed subject matter.

Since claims 4-6, 10-12, and 17-19 each include, *inter alia*, the limitations of the newly amended independent claims 1, 8, and 14, Applicant submits that the cited references do not teach or suggest all of these claim limitations.

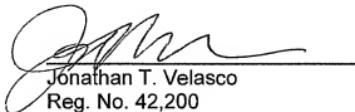
Applicants submit that the claims now are allowable over the combination of the cited reference as none of the above references, alone or in combination, suggest or describe the aforementioned features recited in Applicant's claims. The limitations of pending claims 1, 4-6, 8, 10-12, 14, and 17-19 are not taught or suggested by the prior art cited, and these claims are now patentably distinct and in condition for allowance, which action is respectfully requested.

D. Conclusion

For all the foregoing reasons, allowance of all pending claims is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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